



JJGJr.:07-02

Paper 9

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AUG 1 2002

OFFICE OF PETITIONS

DARBY & DARBY P.C.
805 THIRD AVENUE
NEW YORK NY 10022In re Application of
Cote, et al.
Application No. 09/891,875
Filed: 25 June, 2001
Attorney Docket No. 3795/0J514USO: DECISION REFUSING
: STATUS UNDER
: 37 C.F.R. §1.47(a)
:

This is a decision on the petition under 37 C.F.R. §1.47(a),¹ filed on 16 March, 2002, and supplemented via FAX on 30 July, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and may include an oath or declaration executed by the inventor.

Failure to respond will result in abandonment of the application.

BACKGROUND

The record indicates:

- the application was filed on 25 June, 2001, without an executed oath or declaration for the first-named inventor Harold Côté (Mr. Côté);
- accordingly, a Notice to File Missing Parts of Application was mailed on 17 August, 2001, requiring an executed oath or declaration, and a surcharge for the late filing;
- counsel filed concurrently with the petition the fee, the surcharge for late filing, and certain correspondence (letter of 23 July, 2001, Email of 26 July, 2001, and letter of 20 September, 2001), however, rather than evidencing the pertinent facts establishing that the inventor was first presented with a copy of the complete application, yet refuses to sign or

¹ The regulations at 37 C.F.R. §1.47 provide:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

cannot be found or reached after diligent effort,² the materials demonstrate that only the oath/declaration and an assignment document were submitted to Mr. Côté.

ANALYSIS

Petitioner has failed to establish that the inventor has been presented with the full application and has refused to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events with support of the registered practitioner prosecuting this matter) or cannot be reached.

A copy of the entire application must be sent to the last known address of the non-signing inventor with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached. Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.³

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
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Office of the Deputy Commissioner
for Patent Examination Policy

² The submission should include: (a) a declaration of the registered attorney(s)/agent(s) and other authority(ies) attempting the contact, outlining the efforts and the results; and (b) documentation (such as a copy of the transmittal letter(s) and delivery disposition document(s) supporting that (those) declaration(s).

³ See: MPEP 409.03(b).